

Remarks

In the Office Action dated June 19, 2003, the Examiner rejected claims 1, 9-11, 13, 15-16, 35-38 and 40-41 under 35 U.S.C. § 103 as being unpatentable over U.S. Patent No. 6,356,641 to Waranaka, et al. (hereinafter Waranaka) in view of U.S. Patent No. 5,754,664 to Clark, et al. (hereinafter Clark), claims 2-4, 14 and 17 under 35 U.S.C. § 103 as being unpatentable over Waranaka in view of Clark and further in view of U.S. Patent No. 5,887,071 to House, claims 5-8 under 35 U.S.C. § 103 as being unpatentable over Waranaka in view of Clark and further in view of the U.S. Patent No. 4,385,210 to Marquiss, claims 18-23 and 25-34 under 35 U.S.C. § 103 as being unpatentable over Waranaka in view of Clark and further in view of WO 99/11490 to Azima, et al., claim 39 under 35 U.S.C. § 103 as being unpatentable over Waranaka in view of Clark and further in view of U.S. Patent No. 5,450,057 to Watanabe, and claims 12, 24, 43 and 44 under 35 U.S.C. § 103 as being unpatentable over Waranaka in view of Clark and further in view of U.S. Patent No. 6,337,355 to Yamashita, et al. Claim 42 is withdrawn. By this paper Applicants' representative amends the specification and claim 44 for consistency. As such, no new matter has been added.

With respect to the Examiner's rejections, the Examiner is requested to consider the following remarks.

Applicants' representative respectfully traverses the rejection of the presently pending claims. The Examiner has failed to establish a *prima facie* case of obviousness as is required under 35 U.S.C. § 103 and the rejection should be withdrawn. In particular, independent claim 1 provides an acoustically-insulating headliner adapted to be mounted adjacent a roof, the headliner having an upper surface and a sound-radiating, lower surface, an array of electromagnetic transducer assemblies supported at the upper surface of the headliner, wherein the assemblies convert processed audio signals into mechanical motion of corresponding zones of the headliner. Independent claims 43 and 44 provide similar recitations.

Waranaka corresponds to PCT patent application WO 98/13942. As such, Waranaka was well known and fully considered by the Applicants. (See, the specification on page 4, ll. 13-15). The Examiner contends that Waranaka teaches an array of electromagnetic transducers. However, the Examiner has mis-characterized Waranaka. In particular, Waranaka teaches transducers (15), which in each instance are flat piezoelectric elements. (Waranaka, col. 5, ll. 16-19). As such, Waranaka fails to teach an array of electromagnetic transducers as presently claimed.

Clark was also well known and fully considered by the Applicants. (See, the specification on page 1, l. 27 through page 2, l. 5). The Examiner contends that Clark teaches a headliner that radiates acoustic power into the interior of a vehicle. However, the Examiner has mis-characterized Clark. Clark teaches overhead speakers that are mounted directly to a headliner. (Clark, Abstract). The speakers (i.e., not the headliner as asserted by the Examiner) provide strong front staging and desired surrounding ambience responsive to the output signals of a control circuit. (Clark, Abstract). Furthermore, Clark teaches speakers, not electromagnetic transducers as presently claimed. As such, Clark fails to cure the deficiencies of Waranaka. Therefore, Waranaka and Clark, alone or in combination, fail to provide the claimed features of the present invention and the rejection should be withdrawn.

Furthermore, even if the cited references, alone or in combination, resulted in the presently pending invention, the Examiner has failed to provide the motivation to combine the teaching of Waranaka and Clark as is required for a *prima facie* case of obviousness under 35 U.S.C. § 103(a). The mere fact that references can be combined or modified, which Applicants do not agree is the case with respect to the cited references, does not render the resultant combination obvious unless the prior art also suggests the desirability of the combination or modification. (See, MPEP § 2143.01). In that regard, “[a] prior art reference must be considered in its entirety, i.e., as a whole, including portions that would lead away from the claimed invention”. (See, MPEP § 2141.03, citing *W.L. Gore & Associates, Inc. v. Garlock, Inc.*, 721 F.2d 1540, 220 USPQ 303 (Fed. Cir. 1983), *cert. denied*, 469 U.S. 851 (1984)). “The totality of the prior art must be considered, and proceeding contrary to accepted

wisdom in the art is evidence of nonobviousness". (See, MPEP § 2145, X., 3., citing *In re Hedges*, 783 F.2d 1038, 228 USPQ 685 (Fed. Cir. 1986)). In particular, Waranaka teaches:

Although piezoelectric transducers are preferred, other types of transducers may be used in the invention. For example, the transducer may be a magneto-strictive transducer, an electromagnetic transducer, an electro-static transducer or a micro-motor. In such cases, it is preferred that the transducers be substantially flat. Compared to all of the above embodiments, piezoelectric transducers are preferred because they are much thinner and lighter, which is of extreme importance because of the size and weight limitations faced by current vehicle manufacturers, they run cooler (particularly in reference to an electro-magnetic transducer) and also because they are currently much more economical than all of the variations referenced above. (Waranaka, col. 11, ll. 15-27).

As such, Waranaka teaches away from the implementation of conventional loudspeakers as implemented by Clark, and Waranaka teaches away from the implementation of electromagnetic transducer assemblies, as presently claimed.

The Examiner has also used impermissible hindsight to combine the teachings of Waranaka and Clark to attempt to piece together the Applicants' invention. The teaching or suggestion to make the claimed combination must be found in the prior art, not in the applicant's disclosure. (See, MPEP § 2143; see also, *In re Dembiczak*, 175 F.3d 994, 999 (Fed. Cir. 1999) ("Combining prior art references without evidence of ... suggestion, teaching, or motivation simply takes the inventor's disclosure as a blueprint for piecing together the prior art to defeat patentability—the essence of hindsight.")). The Examiner has failed to provide any motivation for any combination of art that would provide the features of the present invention. In fact, Warnaka teaches away from the implementation of electromagnetic transducer assemblies, as presently claimed.

Regarding the claims which depend from claim 1, Applicants contend that these claims are patentable for at least the same reasons that claim 1 is patentable. Moreover, Applicants contend that these claims recite further limitations, in addition to the limitations of claim 1, which render these claims additionally patentable.

Furthermore, regarding the rejection of claims 18-23 and 25-34 under 35 U.S.C. § 103 as being unpatentable over Waranaka in view of Clark and further in view of WO 99/11490 to Azima, WO 99/11490 to Azima corresponds to U.S. Patent No. 6,377,695 (Azima '695) and has a U.S. filing date of February 10, 2000. (Azima '695, front page, item 22). However, the present application has a filing date of August 25, 1999. As such, WO 99/11490 to Azima fails to be a proper reference under 35 U.S.C. § 103 and the rejection should be withdrawn.

Consequently, in view of these remarks, Applicants respectfully contend that the rejections have been fully replied to and traversed, and that the application is in condition for allowance, and the Examiner is respectfully requested to pass this case to issue. No fee is believed to be due for the filing of this paper. Please charge any additional fees or credit any overpayments as a result of the filing of this paper to our Deposit Account No. 02-3978.

The Examiner is requested to telephone the undersigned to discuss prompt resolution of any remaining issues necessary to place this case in condition for allowance.

Respectfully submitted,

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